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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/872,226

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Darrel D. Cherry

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EXAMINER

BEKIRMAN, MICHAEL

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

05/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/872,226

Applicant(s)

CHERRY ET AL.

Examiner

MICHAEL BEKERMAN

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to papers filed on 3/11/2008.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 1-13, 15-22, and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
2. **Regarding claims 1, 10, 19, and 22,** these claims recite the limitation "bonus material different from content in the media and the advertisements". The only bonus material recited in the specification appears in paragraph 0039, which recites examples of the bonus material as being "additional articles corresponding to the user's interests" or "samples of other media published by the content provider". It appears that this bonus material could comprise *additional* content in the media or *additional* advertisements (samples). Thus, the specification does not recite a bonus material that is necessarily different than the content material or advertisements, but rather bonus

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material that comprises *additional* content material or advertisements. *Dependent claims 2-9, 11-13, 15-18, 20, 21, and 24 also inherit this rejection.*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-13, 15-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kent (U.S. Pub No. 2002/0040374) in view of Zehr (U.S. Pub No. 2001/0025274) and further in view of Hanson (U.S. Patent No. 5,974,398).**

Regarding claims 1-4 and 6-8, Kent teaches storing advertisements (Paragraph 0079, Sentence 1) and media selections (Paragraph 0058, Sentence 1), communicating with a remote device (Paragraph 0083, Sentence 1), printing hardcopy media products (Paragraph 0083, Sentence 1), retrieving information from a user (Paragraph 0038, Sentence 1), and displaying lists of available media selections (Paragraph 0038, Last Sentence). Media publisher computers and advertisement providers are inherent in the system. Kent further teaches a user profile database (Paragraph 0031, Sentence 1), a media database (Paragraph 0058, Sentence 1), and an advertisement database ((Paragraph 0012). Kent further teaches samples (bonus material separate from the magazine content and printed advertisements) that can be included in the magazine (Paragraph 0072).

Kent doesn't specify the advertisement data is also having corresponding bid amounts. Zehr teaches a personalized publication system and method that takes bid amounts into consideration (these bid amounts are inherently stored in relation to the advertisements) (Paragraph 0043, Sentence 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to auction advertisements in personalized publications. This ensures that advertisers willing to pay higher prices for better placement are accommodated. Since bidding takes place in Zehr, to determine bid amounts an advertising potential value is inherently determined. The bid amount can be read on a potential value for the advertisement. Zehr teaches an advertiser as letting the system know what the bid increments are and what the ceiling value is. Thus, bidding is handled automatically and programmatically (Paragraph 0043). Zehr also teaches the price an advertiser is willing to pay as varying based on size of the advertisement and location (position) of the advertisement (Paragraph 0047, Sentence 8).

While Zehr teaches a bidding system in which advertisers assign a ceiling value and bid increments to let the system automatically bid, it could be argued that this does not signify an advertising potential value that is automatically determined from data received from a service provider. Hanson teaches a method used by advertisers to bid for the attention of consumers in which advertisers can specify age or income (user profile data) or they can establish algebraic formulas that automatically relate a bidding value to age or income profile data (Column 6, Lines 1-5). The algebraic formula would inherently require an input from the system indicating age or income of an individual to

automatically determine the bid value for a particular situation, which in this case would be synonymous with a potential value. In this situation, the algebraic formula could output a bid value of \$0.00, which signifies that the bid is not worth placing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to set up a program or algebraic formula to automatically determine how much to bid for ad placement before certain individuals. This automated process would help the advertiser make decisions more quickly.

Regarding claims 5, 21, and 24, Kent teaches that user demographic information includes user preferences (Paragraph 0038, Sentence 1).

Regarding claims 9 and 11-13, Kent teaches a user as registering (subscribing) with a publication (Abstract). Kent doesn't specify that a user needs to log in or is assigned a password to authenticate. Official notice is taken that it is old and well known to be assigned and input log-in identification when giving personal preference information online. Authentication is used by Amazon.com (as well as numerous other online retail sites and publication sites) to store wish lists and user preference information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to assign an identifier to a subscriber and use authentication methods to verify said subscriber. This would allow subscribers to change preference information when needed.

Regarding claims 10, 15, 17-19, and 22, Kent teaches inputting user personal information (Paragraph 0038, Sentence 1), obtaining a media request from a user (subscribing is a request) (Paragraph 0038, Last Sentence), querying at least one

advertising provider for an advertisement and receiving the advertisement in electronic form (the advertisements are inherently received from an advertising provider, and since the advertisements are accessed by the optimization program, they are inherently in electronic form) (Paragraph 0079, Sentence 1), and merging the media and the advertisement for the user (Paragraph 0062, Sentences 1-2). Kent further teaches samples (bonus material separate from the magazine content and printed advertisements) that can be included in the magazine (Paragraph 0072).

It can be argued that Kent does not go into detail about which information is exchanged between the advertiser and the media creation service. Kent also does not specify bidding for advertisements. Zehr teaches receiving advertisement information from a media creation service (logging in to place an order) (Paragraph 0040) and sending an advertisement and bid in electronic form (Paragraph 0040 and 0043). Zehr also teaches the price an advertiser is willing to pay as varying based on size of the advertisement, location (position) of the advertisement (Paragraph 0047, Sentence 8), or number of times in which the advertisement is printed (Paragraph 0040). By logging in to place an order, an advertiser is privy to all of the advertising options (information) sent from and determined by the media creation service, and uses these options to determine how much to pay for an advertisement. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the advertisement order placement system of Zehr with the system of Kent. This would create an easier interface for advertisers to determine how much to pay for placement of an ad. Since bidding takes place in Zehr, to determine bid amounts an advertising

potential value is inherently determined. The bid amount can be read on a potential value for the advertisement. Zehr teaches an advertiser as letting the system know what the bid increments are and what the ceiling value is. Thus, bidding is handled automatically and programmatically (Paragraph 0043).

While Zehr teaches a bidding system in which advertisers assign a ceiling value and bid increments to let the system automatically bid, it could be argued that this does not signify an advertising potential value that is automatically determined from data received from a service provider. Hanson teaches a method used by advertisers to bid for the attention of consumers in which advertisers can specify age or income (user profile data) or they can establish algebraic formulas that automatically relate a bidding value to age or income profile data (Column 6, Lines 1-5). The algebraic formula would inherently require an input from the system indicating age or income of an individual to automatically determine the bid value, which in this case would be synonymous with a potential value. In this situation, the algebraic formula could output a bid value of \$0.00, which signifies that the bid is not worth placing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to set up a program or algebraic formula to automatically determine how much to bid for ad placement before certain individuals. This automated process would help the advertiser make decisions more quickly.

Regarding claim 16, Zehr teaches receiving bids for advertisements and selecting a winning bid (Paragraph 0043). Comparing the bids is inherent for selecting

a winning bid, and informing the advertising provider of the winning bid is inherent when a bill is sent.

Regarding claim 20, Zehr teaches that the advertisement provider bids up for certain ads to reach certain individuals (Paragraph 0043, Sentence 1).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL BEKERMAN** whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B./
Examiner, Art Unit 3622

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622